

U.S. Serial No. 10/690,150
Amendment Dated April 11, 2005
Response To Office Action Dated January 11, 2005

REMARKS

The pending application was filed on October 21, 2003 with claims 1-25. The Examiner issued a Non-Final Office Action dated January 11, 2005 objecting to claims 9-10 and 16-17. However, the Examiner indicated that claims 9-10 and 16-17 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Examiner also rejected claims 1-8, 10-15, and 18-25. In particular, the Examiner rejected claims 21-25 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner also rejected claims 1-4, 6, 7-9, 11-15, and 18-20 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 4,423,820 to *Katz*. The Examiner also rejected claims 3, 11, 18, and 20 by taking official notice that such elements would have been obvious to one skilled in the art at the time the invention was made.

Claims 1-25 remain pending in the patent application. In view of the arguments set forth below, claims 1-25 are allowable, and the Examiner is respectfully requested to withdraw the rejections and issue a timely Notice of Allowance.

I. OBJECTION TO DRAWINGS

The Examiner objected to the drawings under 37 CFR 1.83(a) asserting that the drawings fail to show how the invention is fitted to a sprinkler head as described in the specification. In addition, the Examiner stated that the specification does not include a

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reference pointing out the "glass bulb" on the sprinkler shown in Figure 1. The Examiner cited, as support for his statement, MPEP §608.02 as suggesting that any structural detail that is essential for a proper understanding of the disclosed invention be shown in the drawing.

Title 35 of the United States Code, Sec. 112, first paragraph states that "[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention." In addition, Title 35 of the United States Code, Sec. 113 states, in relevant part, "[t]he applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented" (emphasis added). As shown in the pending patent application, figures 1-5 were submitted together with the written specification and show various aspects of the invention. In addition, the specification describes how, during use, a deflated bladder is positioned between a support structure 28 and a port 30 of a conventional fire sprinkler head 32 in the paragraph beginning at page 8, line 13 and in the paragraph beginning at page 9, line 4. The specification adequately describes that during use of the fire sprinkler discharge control device of the invention, the control device is inserted between the support structure and the port 30 of a fire sprinkler head 32. A person of ordinary skill in the art is well aware of the existence of the gap that exists between the port 30 and support structure 28. Furthermore, the gap is clearly visible

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when viewing Figure 1. Thus, the description of the use of the fire sprinkler discharge control device of the invention in the specification adequately discloses the invention and the method of using it as required by 35 U.S.C. §112 without a separate figure showing the fire sprinkler flow control device inserted through the gap formed between the support structure 28 and the port 30.

Furthermore, the Examiner's request that the specification be amended to identify the "glass bulb" in the conventional sprinkler head is unnecessary in Applicant's view. Figure 1 displays a conventional sprinkler head that is well known to one of ordinary skill in the art. There is no requirement that a patent application include drawings that describe prior art technology. In addition, identifying the glass bulb, which is already known by those of ordinary skill in the art, does not assist one of ordinary skill in the art in understanding how to make or use the invention because one of ordinary skill in the art already has this knowledge. The Examiner should note that the invention is utilized after the glass bulb has been destroyed, according to conventional usage, and therefore its depiction is unnecessary for comprehension of the invention. Thus, for at least these reasons, the Examiner is respectfully requested to withdraw the rejection.

II. CLAIM REJECTIONS UNDER 35 U.S.C. §112

The Examiner rejected claims 21-25 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner stated that the claims contain

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subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use in the invention. In particular, the Examiner wrote that the specification fails to provide methodology as to how compressed air source is used for inflating a bladder to "at least equal to the water pressure found in the sprinkler." The Examiner further stated that such language does not account for systems that provide specific high pressures, nor does it include a range of pressure normally found.

The method of using the fire sprinkler discharge control device to control the flow of fluids from a fire sprinkler is adequately described in the specification. Claims 21-25 are directed to a method of controlling discharge of fluids from a fire sprinkler and include "inflating a fire sprinkler discharge control device . . . ," which is adequately supported by the specification. The claims do not include a range of pressure normally found in fire systems or the pressure found in high pressure systems.

The Examiner's statement that the claims are unpatentable under 35 U.S.C. §112 because the specification does not provide a range of pressure found in conventional fire suppression sprinkler systems is traversed. Such pressures are known to those of ordinary skill in the art and are thus not required to be discussed for one of ordinary skill in the art to understand how to make and use the invention without such a discussion. The specification discloses how to position and inflate the fire sprinkler control device to control fluid flow from a port in a conventional fire sprinkler. A discussion of the range of typical fluid

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pressure found in a conventional fire sprinkler system is simply not needed nor required to support the claims. The specification states that the pressure in the bladder meet or exceed the pressure in the fire suppression system so as to prevent further discharge by the system. As such, the specification would be comprehended by one having even minimal competency in this art. Furthermore, a discussion of conventional high pressure systems is unwarranted as well. No mention of conventional high pressure systems is found in the specification. Therefore, for at least these reasons, the Examiner is respectfully requested to withdraw the rejection.

III. CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

The Examiner rejected claims 1-4, 9, 11-15, and 18-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,423,829 to *Katz*. The Examiner stated that *Katz* discloses a device having a bladder (36) with a valve (68) that can be coupled to a fluid supply with a clamp (17). However, the Examiner admitted that *Katz* does not disclose a device configured to fit between a support structure of a fire sprinkler and the exhaust port. The Examiner stated that fire sprinklers are well known in the prior art and concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed the device of *Katz* to seal the exhaust port of an actuated fire sprinkler during a fire emergency to plug the sprinkler and combat the fire by standard fire-extinguishing methods.

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"To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or reference when combined) must teach or suggest all of the claim limitations." MPEP 2143 (emphasis added). In addition, "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In this case, *Katz* discloses an apparatus for containing and dispensing a liquid under pressure. The apparatus disclosed in *Katz* is formed from a resilient tubular container with a flexible inner sleeve for containing a fluid. The *Katz* reference discloses use of the apparatus to contain fluids in the container and "to permit selective amounts of the pressurized fluid to exit the flexible container" column 3, lines 32-33. *Katz* does not disclose, or even suggest, using the container disclosed in *Katz* as a fire sprinkler discharge device. In *Katz*, the resilient container contains the liquid. In contrast, the bladder in the claimed invention is used only as a stopper of sorts to block the flow of the liquid. These are completely different issues. The Examiner's conclusion that the apparatus disclosed in *Katz* may be used as a fire sprinkler control device is impermissible hindsight.

Pending independent claim 1 states "[a] fire sprinkler discharge control device, comprising: at least one bladder adapted to fit between a support structure of a fire sprinkler

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and an exhaust port of a fire sprinkler for sealing the exhaust port of the fire sprinkler." In contrast, *Katz* does not disclose a fire sprinkler discharge device as claimed in independent claims 1, 13, or 21, or those claims depending therefrom. Functional language does not render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). In addition, use of the phrase "adapted to" has been held to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). Thus, independent claims 1, 13, and 21, and all claims depending therefrom are clearly distinguishable from *Katz* and patentable as written. The Examiner is respectfully requested to withdraw the rejection and issue a Notice of Allowance.

The Examiner also rejected claims 6, 7, 8, 12, 14, and 15 and stated that *Katz* discloses that polypropylene, a substance impermeable to fluids, or "any other suitable material" can be used for the materials to produce the bladders. The Examiner concluded that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have included latex as a suitable material for the construction of a bladder.

The Examiner apparently relied on the statement in *Katz* that the inner sleeve may be formed from the materials set forth above and may be formed from "any other suitable material" as disclosure for forming a bladder from latex. A statement, as in *Katz*, that a sleeve may be formed from any other suitable material is not sufficient for teaching that a

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sleeve may be formed from another material. Such a conclusion is an exaggeration and amounts to impermissible hindsight.

The Examiner also stated that as referring to claims 11 and 20, official notice was taken to the claim that an invention's outer bladder be given a wear resistant coating. The Examiner stated that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have considered the hostile environment of a burning structure and to have coated the outside cover of a fire discharge control device with a wear resistant coating.

Katz, as admitted by the Examiner, does not disclose a wear resistant coating. However, concluding that such a coating may be applied when an item is used in the hostile environment of a burning structure is impermissible hindsight as well. In addition, claims 11 and 20 depend from independent, allowable claims 1 and 13, respectively. Therefore, for at least these reasons, claims 11 and 20 are allowable, and the Examiner is respectfully requested to withdraw the rejection.

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CONCLUSION

For at least the reasons given above, claims 1-25 define patentable subject matter and are thus allowable. The undersigned representative thanks the Examiner for examining this application.

Should the Examiner believe that anything further is necessary in order to place the application in better condition for allowance, the Examiner is respectfully requested to contact the undersigned representative at the telephone number listed below.

No fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 50-0951.

Respectfully submitted,



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